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EXAMINER	
CHAI, LONGBIT	

ART UNIT	PAPER NUMBER
2431	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/660,302	AYARS ET AL.	
	Examiner	Art Unit	
	LONGBIT CHAI	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Currently pending claims are 1 – 3 and 5 – 32.

Response to Arguments

2. Applicant's arguments with respect to instant claims have been fully considered but are moot in view of the new ground of rejection ***necessitated by Applicant's amendment***.

Claim Objections

3. Claim 19 is objected to because of the following informalities: "a selection of one a plurality of digital rights" should be replaced with "a selection of one from a plurality of digital rights". Appropriate correction(s) is (are) required. Any other claims not addressed are objected by virtue of their dependency should also be corrected.

4. Claim 23 is objected to because of the following informalities: "the file format type module" should be replaced with "the file format type transcoding module". Appropriate correction(s) is (are) required. Any other claims not addressed are objected by virtue of their dependency should also be corrected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter where "A computer readable medium containing instructions" as

recited in the claim may be reasonably interpreted as being not limited to computer readable storage medium (SPEC: Para [0017]: only a communication medium is disclosed while a computer readable medium is not clearly defined in the specification) – i.e., it may be intended to include communication medium (as one type of computer readable media) that may include signals / carrier waves which "bear" instructions as claimed. Such embodiments of the "manufacture" are not computer elements which define structural and functional interrelationships between the instructions and the rest of the computer that permit the functionality of the instructions to be realized. Examiner respectfully suggests an amendment of the claim language from "A computer readable medium" to "A computer readable storage medium" for clarity purpose.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 11, 17 – 18 and 31 – 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

7. As per claim 11, Examiner notes the new matter of "an identifier of a first digital rights management transcoding module", which was amended into the claim limitation in the amendment filed on 12/08/2008 that was not originally filed on 9/10/2003 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. On this regard, Examiner respectfully notes according to the disclosure of the instant (SPEC: Page 12, Para [0036] – [0037]), an identifier of a DRM system instead of an identifier of digital rights management transcoding module is disclosed – this is because of, e.g., defining a computer

system ID is not necessarily to support defining a specific component / module ID, as recited in the amended claim. NOTE: Any other claims not addressed are rejected by virtue of the same rationale should also be corrected.

8. As per claim 17, Examiner notes the new matter of "writing the generated digital rights management system rules to the output file according to the first digital rights management technique via a transcoding module", which was amended into the claim limitation in the amendment filed on 12/08/2008 that was not originally filed on 9/10/2003 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. On this regard, Examiner respectfully notes Applicant is requested to clearly identify the amendments and to indicate the corresponding passage that has been disclosed in the original specification of the instant application.

9. As per claim 18 and 31 – 32, Examiner notes the new matter of "writing the mapped / generated rules to the output file via a transcoding module", which was amended into the claim limitation in the amendment filed on 12/08/2008 that was not originally filed on 9/10/2003 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. On this regard, according to the disclosure of the instant specification, a mapped DRM system is used to write the output file (SPEC: Page 14 Para [0042]: i.e. to write the output file according to a mapped DRM system), which is different from" writing the mapped rules to the output file via a transcoding module", as recited in the amended claim. Applicant is requested to clearly identify the amendments and to indicate the corresponding passage that has been disclosed in the original specification of the instant application. NOTE: Any other claims not addressed are rejected by virtue of the same rationale should also be corrected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 – 3, 5 – 11 and 15 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Safadi (U.S. Patent 2003/0126086).

As per claim 1, Safadi teaches a method of securing delivering digital media (Safadi: Para [0013] Line 7), the method comprising:

receiving digital media from a first device (Safadi: Para Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18);

receiving a selection of a plurality of transcoding modules, including a file format module and at least one of a compression module and an encryption module (Safadi: Para [0031] Line 3, Para [0026] Line 4 – 17, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: (a) a computer software module, according to DICTIONARY.com, is interpreted as part of a program that performs a distinct function such as encrypting/decrypting, compressing, formatting and etc., and (b) both encryption/decryption module and format conversion module are qualified as one type of transcoding modules that transform the digital content code, (c) if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded

and guarantee to decode with a *selected* known decoding technique according to a known consumer device, and (d) one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media);

transforming the data digital media in accordance with the selected transcoding modules (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12); and

delivering the transformed digital media to a second device (Safadi: Para [0021] Line 18 – 20 and Para [0028]: a consumer device is qualified as a second device).

As per claim 19, Safadi teaches a method of handling digital media (Safadi: Para [0013] Line 7), the method comprising:

receiving electronic data encrypted according to a first digital rights management system via a transcoding module (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18: (a) a computer software module, according to DICTIONARY.com, is interpreted as part of a program that performs a distinct function such as encrypting/decrypting, formatting and etc., and (b) both encryption/decryption module and format conversion module are qualified as one type of transcoding modules that transform the digital content code);

receiving a selection of one a plurality of digital rights management transcoding modules to be applied to the data, wherein the first digital rights management transcoding module and the selected digital rights management transcoding module are

different (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: one of the selected digital rights management transcoding module is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media);

decrypting said electronic data via a transcoding module (Safadi: Para [0028] Line 1 – 3); and

re-encrypting said electronic data in accordance with said selected digital rights management transcoding module (Safadi: Para [0028] Line 1 – 12).

As per claim 8 and 11, Safadi teaches a method of securely distributing digital media (Safadi: Para [0013] Line 7), the method comprising:

receiving a selection of at least one of a plurality of transcoding modules (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: (a) a computer software module, according to DICTIONARY.com, is interpreted as part of a program that performs a distinct function such as encrypting/decrypting, compressing, formatting and etc., and (b) both encryption/decryption module and format conversion module are qualified as one type of transcoding modules that transform the digital content code, (c) if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded and guarantee to decode with a *selected* known decoding technique according to a known consumer device, and (d) one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer

device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media);

receiving a plurality of digital data files, the files utilizing a plurality of different file format types (Safadi: Para [0021] Line 11 – 15 and [0017] Line 7 – 12 / Line 16 – 18: each of the consumer devices uses its own unique format type);

receiving a selection of a plurality of file format types (Safadi: Para [0021] Line 11 – 15 and [0017] Line 7 – 12 / Line 16 – 18: each of the consumer devices uses its own unique format type and a selection of a plurality of file format types is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices);

reformatting the files via the selected at least one of the transcoding modules and in accordance with the format types (Safadi: Para [0026] Line 4 – 17, Para [0021] Line 11 – 15 and [0017] Line 7 – 12 / Line 16 – 18: convert the format type from the original format to native format associated with each of the consumer devices that uses its own unique format type);

receiving a user selection of a first digital rights management transcoding module, the first digital rights management transcoding module being one of a plurality of pre-determined digital rights management transcoding modules (Safadi: Para [0021] Line 11 – 15 and [0017] Line 7 – 12 / Line 16 – 18: the selection is based upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices);

encrypting the reformatted files according to the selected digital rights management transcoding module (Safadi: Para [0031] Line 3 and Para [0028] Line 1 – 12: for

data protection by encrypting the digital data content having consumer device's own unique format); and

transmitting the encrypted files to a plurality of consumers (Safadi: Para [0021] Line 18 – 20 and Para [0028]).

As per claim 2, 3 and 20, Safadi teaches receiving data digital media encrypted according to a first digital rights management system, wherein the first and selected digital rights management systems are different (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded and guarantee to decode with a *selected* known decoding technique according to a known consumer device, and one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media).

As per claim 5 and 6, Safadi teaches a consumer / operator selects said plurality of transcoding modules (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: if a consumer device could not decrypt (e.g., the content is encrypted using a different encrypting technique), the device might crash during the decoding / decrypting process and as such all bitstream *MUST* be encoded and guarantee to decode with a *selected* known decoding technique according to a

known consumer device, and one of the selected digital rights management transcoding module, as taught by Safadi, is depending upon an unique / particular type of native DRM scheme associated with a given consumer device (from a plurality of user devices), which is *different* from the original type of DRM scheme used by a content provider when downloading a digital media).

As per claim 7, Safadi teaches a driver module is configured to select said plurality of transcoding modules (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: ***Examiner notes*** a driver module is merely a software module that performs code / data translation in accordance with an input / output file format compatible with an input / output device).

As per claim 9, Safadi teaches decrypting the at least one file in accordance with the first digital rights management system prior to reformatting the at least one file via a transcoding module

(Safadi: Para [0028] Line 1 – 12: ***Examiner notes*** a driver module is merely a software module that performs code / data translation in accordance with an input / output file format compatible with an input / output device).

As per claim 10, Safadi teaches using the dynamically-created format transcoding module or writer transcoding module to reformat the files (Safadi: Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12: using a dynamically-created format to match with the type used by the consumer device).

As per claim 16 (& Claim 15), Safadi teaches decrypting the input data according to the rules of the second digital rights management system via a transcoding module (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12).

As per claim 17 (& Claim 18), Safadi teaches a generating digital rights management system rules, and writing the generated digital rights management system rules to the output file according to the first digital rights management technique via a transcoding module (Safadi: Para [0031] Line 3, Para [0028] Line 1 – 4, Para [0015] Line 1 – 7 and Para [0017] Line 7 – 12 / Line 16 – 18 and Para [0028] Line 1 – 12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 12 – 14 and 21 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safadi (U.S. Patent 2003/0126086), in view of Suzuki et al. (U.S. Patent 6,463,445).

As per claim 23 and 27 (& Claim 12 – 14 and 21 – 32), the claim limitations are met as the same reasons as that set forth in the paragraph above regarding to claims 1, 8, 11 and 19 with the exception of (a) reciting a “translation driver”, a “transcoding module library” or a “compressing / decompressing technique". Examiner notes Safadi teaches a translation driver (Safadi: Para [0017] Line 16 – 18: a transcoder module may be provided for transcoding the

content from an original format to a native format compatible with the consumer device and as such the transcoder module, as taught by Safadi, is also qualified as a translation driver which is also consistent with the disclosure of the instant specification (SPEC: Para [0027] Line 1 – 2: ***Examiner notes*** a translation driver is merely a software module that performs code / data translation in accordance with an input / output file format(s) that includes receiving an input file with a file identifier (NOTE: each file must contain a file ID), determining the proper file format and then outputting a new output file with a user desired format).

However, Safadi does not disclose expressly a “transcoding module library” or a “compressing / decompressing technique".

Suzuki teaches a “transcoding module library” and a “compressing / decompressing technique" (Suzuki: Abstract / Line 1 – 7, Column 12 Line 55 – 67, Column 1 Line 44 – 67, Column 2 Line 38 – 46 and Column 3 Line 38 – 45: providing a transcoding tool library - especially “format conversion” including the encoding format associated with compression technique, used in the multimedia bitstream which is originated by a contents server / provider).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Sun within the system of Safadi because (a) Safadi teaches a digital right management system that efficiently and transparently converts the digital data formats used between a content provider and a consumer device (Safadi: Para [0015] Line 1 – 7, Para [0017] Line 7 – 12 / Line 16 – 18), and (b) Suzuki teaches providing an effective multimedia information retrieval system including a method for automatic data format conversion by using a transcoding tool library - especially “format conversion” including the encoding format associated with compression technique, used in the multimedia bitstream which is originated by a contents server / provider (Suzuki: Column 12 Line 55 – 67 and Abstract / Line 1 – 7).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LONGBIT CHAI whose telephone number is (571)272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Longbit Chai/

Primary Examiner, Art Unit 2431
12/15/2008